

## **REMARKS**

Applicants appreciate the notification of allowable subject matter, i.e. that claims 8, 28, 29, 34 and 35 are allowed.

The specification and claims 1, 4, 8, 9, 10, 38 and 39 have been amended, and claims 40-41 have been added. No new matter has been added by virtue of the amendments. For instance, the amendments generally relate to non-substantive matters of form. Certain recited substituent groups have been deleted or excluded. Support for the amendments also appear in the original claims of the application.

As set forth at pages 2-4 of the Office Action, the specification was objected to under 35 U.S.C. 132 and claims 1, 10, 24, 25 and 32 were rejected under 35 U.S.C. 112. As grounds for the objection and rejection, the recitation of pyridylmethyl, pyridylethyl and imidazolylethyl are noted.

While Applicants fully disagree with the objection and rejection, including for reasons set forth in Applicants' prior response, it is also believed the amendments made herein obviate the objection and rejection. In particular, "pyridylmethyl, pyridylethyl and imidazolylethyl" have been deleted from page 3 of the specification and independent claim 1.

In view thereof, reconsideration and withdrawal of the objection and rejection are requested.

Claim 1 is rejected under 35 U.S.C. 102 over Bock et al. (U.S. Patent 5834464). As the rejection is understood, the sole basis fore the rejection is the reagent compound recited at column 18, lines 4-6 of Bock et al. The rejection is traversed.

Claim 1 as amended does not overlap with the cited Bock et al. compound. Thus, the cited Bock et al. compound has a substituent  $-\text{NH}-\text{CH}(\text{CH}_3)-\text{CH}_2-\text{OH}$ , which is not provided for in Applicants' claim 1.

In view thereof, reconsideration and withdrawal of the rejection are requested.

At page 5-6 of the Office Action, the specification is further objected to under 35 U.S.C. 132.

It is believed that the amendment made herein of page 3 of the specification obviates the objection.

The specification was further objected to under 35 U.S.C. 132 and claims 38 and 39 were rejected under 35 U.S.C. 112, first paragraph. As stated at page 6 of the Office Action, the position is taken that:

"[t]he specific definition of two species, i.e. the species where n is 2 in claims 38 and 39 are not specifically described in the specification with respect to the genus of Formula (I)."

The objection and rejection are traversed.

The noted species are described in the specification as filed. Thus, for the compound recited in claims 38 and 39, attention is directed to the compounds of original claims 6 and 7 where  $m=2$  is recited, which designates the same compounds as now disclosed in claims 38 and 39. Withdrawal of the objection and rejection are therefore requested.

Claims 1, 4, 5, 9-14, 24, 25, 32, 38 and 39 were rejected under 35 U.S.C. 112, second paragraph for typographical-type matters.

The non-substantive typographical-type matters noted in the Office Action have been addressed by the amendments made herein. Thus, for instance, the additional recitation of "p" has been removed from claim 1. In claim 4, the semi-colon has been replaced with a colon. The moiety  $-\text{CH}_2\text{CH}(\text{CH}_3)_2$  is now recited in claim 4. The zeros have been replaced in claims 4 and 9 with O. Claim 10 has been corrected to recite  $\text{R}^5$ . Periods have been added to claims 38 and 39.

Withdrawal of the rejection is therefore requested.

Claims 4 and 5 were rejected under 35 U.S.C. 102 over Yukimasa et al. (U.S. Patent 5,698,691). The grounds for the rejection are the species reported in examples 11 and 15 of Yukimasa et al.

Claims 4 and 5 were rejected under 35 U.S.C. 102 over Thorsett et al. (WO 98/38177). The grounds for the rejection are compounds recited in example 8 of Thorsett et al.

Claims 4 and 5 were rejected under 35 U.S.C. 102 over Wu et al. (U.S. 2002/0055500). The grounds for the rejection are compounds recited in example 8 of Wu et al.

For the sake of brevity, these three Section 102 rejections of claims 4 and 5 are addressed in combination.

Claims 4 and 5 as amended herein recite "provided that when  $\text{R}^1$  is  $\text{CH}_3$  or benzyl then  $m=1$ ". New claims 40 and 41 recite that  $\text{R}^1$  is  $\text{CH}_2\text{CH}_3$ ,  $(\text{CH}_2)_2\text{CH}_3$ ,  $(\text{CH}_2)_3\text{CH}_3$ ,  $\text{CH}(\text{CH}_3)_2$ ,  $\text{CH}_2\text{CH}(\text{CH}_3)_2$ ,  $\text{C}(\text{CH}_3)_3$ , or 4-pyridylmethyl.

None of the Yukimasa et al., Thorsett et al. or Wu et al. document disclose such compounds. Accordingly, withdrawal of the rejections are requested. See, for instance, See *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) (“[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.”)

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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